

DOCKET NO: 0557-4696-2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
KOHJI TAKAHARA : EXAMINER: PAULA, C. B.
SERIAL NO: 09/330,056 :
FILED: JUNE 11, 1999 : GROUP ART UNIT: 2178
FOR: IMAGE INFORMATION SERVER :
FOR STORING IMAGE INFORMATION

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Final rejection of April 9, 2008, Applicants respectfully request a Pre-Appeal Brief Conference for the present application.

ERRORS IN THE REJECTION¹

I. The Statement for the Rejection References Fish, but Fish is not Referenced at any Point in the Grounds for Rejection

The outstanding rejection in prenumbered paragraph 6 references Fish as a basis for the rejection. However, that reference to Fish is never cited in the explanation of the rejection. Thereby, the rejection is improper and must be withdrawn.

II. The Applied Art Does Not Disclose or Suggest “a scanner having a document feeder connected to the image information storing server, not through the client devices”

¹ Claims 1-3, 8-10, 15-17, and 22-42 are pending in this application. Claims 1-3, 8-10, 15-17, and 22-42 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. patent 4,760,606 to Lesnick et al. (herein “Lesnick”) in view of U.S. patent 5,666,490 to Gillings et al. (herein “Gillings”) and further in view of the Microsoft Publication “Getting Results with Microsoft Office 97”, 1997, pp. 376-381 (herein “Microsoft Office”), and further in view of U.S. Patent Application Publication 2007/0239609 A1 to Fish et al. (herein “Fish”).

The claims recite “a scanner having a document feeder connected to the image information storing server, ***not through the client devices***” (emphasis added).

In the various figures in Lesnick the scanner is always connected to a computer, scanned data is input to the computer, and such a computer would correspond to the claimed “client devices”. For example in Figure 2 in Lesnick the OCR device 205 is connected to the computer 202, and similarly in Figures 3 and 4 a scanning operation through a scanner takes place through a computer or client device. The claims as written recite a different feature.

III. The Applied Art Does Not Disclose Or Suggest Specific Features Of The “Group Name Table” And How That Table Is Utilized

The claims recite a group name table storing registered group names and corresponding user names for each respective group name, and the image information server “configured to store (1) the group name table and (2) image data in various folders to be read by the plurality of users”. Independent claim 1 specifically recites

wherein when the first sheet of format image data indicates a group name previously registered in the group name table, a controller determines if the group name is registered by retrieving the group name table, and if the group name is registered in the group name table, the image information server stores the sheet image data in an applicable folder or file of each registered user corresponding to the group name[.]

With respect to the above-noted features the Office Action cites Microsoft Office, stating “Office teaches creating a personal distribution list, containing the names of every one in the distribution group (page 380)”.²

The Microsoft Office system discloses providing distribution lists for e-mail messages, and the user must select to which distribution list to send data.

In contrast to Microsoft Office, in the claims a specific “first sheet of format image data indicates a group name”, the “controller determines if the group name is previously

² Office Action of April 9, 2008, middle of page 4.

registered in the group name table”, if the group name is registered “by retrieving the group name table”, then “the image information server stores the document image data in an applicable folder or file of each registered user corresponding to the group name”. That is, in the claims a determination is made as to whether a specific document includes a group name previously registered in a group name table, and if the group name is registered by retrieving the group name table. In the Microsoft Office a user must set up a personal distribution list. Microsoft Office does not have any operation to automatically indicate whether any distribution list is registered, or whether any document or input includes a group name.

Even the noted distribution lists in the Microsoft Office system are always stored in a client, and are generally used by the same client when mailing and storing senders’ comments in a prescribed folder or a file of a recipient in a mail server.

In contrast to the operation in the Microsoft Office system, in the claims the “group name table” is registered in the image information storing server, not in the client, and is then used, i.e. retrieved, from that same server to confirm if the group name read from the sheet exists in the group name table. The Microsoft Office system does not disclose any type of operation.

In maintaining the outstanding rejection, the Office Action states “the software in Office could be placed on a central server”.³

In reply, the Microsoft Office system as applied is cited so that users at individual stations can provide distribution lists for email messages, and thus in the Microsoft Office system the user must select to which distribution list to send data. Any placement of the software on a central server would not be directed to the claimed features.

³ Office Action of April 9, 2008, page 10, first full paragraph.

Another basis for maintaining the outstanding rejection cites Gillings to disclose “distributing documents based on work group names used to index the documents (column 6, line 46-column 7, line 16)”.⁴

In reply, applicant notes Gillings discloses “[w]orkflow queues are used for distributing work to users and for selecting workflow items requiring an action ... Each workflow queue is assigned to a specific workgroup. Only users in the assigned work group can access items in a given work flow queue.”⁵

Gillings discloses after scanning each page a document can be indexed to enable document tracking and routing, see Gillings at column 5, line 66 to column 6, line 1. That disclosure in Gillings of indexing a document to be tracked and routed is **not** directed to the same features as in the cited “workflow queues”. That further emphasizes the rejection is misconstruing the teachings of the “workflow queues” in Gillings. The “workflow queues” in Gillings are **not** directed to distributing documents based on any type of indexing, but instead Gillings discloses a document tracking and routing unrelated to the “workflow queues”.

IV. The Teachings In The Microsoft Office Are Not Properly Applicable To The Other Cited Teachings In Lesnick Or Gillings

The claims are directed to an image scanning technology. In contrast the Microsoft Office employs a typical computer network technology with a keyboard, a dialog box, a program, etc. In the Microsoft Office system a group address is associated with user addresses only utilizing a keyboard of a PC.

In contrast, the claims recite a format sheet read by a scanner. Thus, in the claims a group name inputting is executed at a different device and accordingly at a different place

⁴ Office Action of April 9, 2008, page 9, second paragraph.

⁵ Gillings specifically at column 6, line 65 to column 7, line 4.

than in the Microsoft Office. In the claims the group name inputting is executed at a scanner. In the Microsoft Office the only group name inputting is at a PC. The Microsoft Office requires the use of keyboard to even make such an entry.

In the Microsoft Office system the user must walk to a PC and input a group name or the like using a keyboard after scanning an image with a scanner, and thereby inputting such a group name or user name becomes a more time consuming and difficult operation. Such disclosures in the Microsoft Office have no relevance whatsoever to Lesnick or Gillings beyond noting that a distribution list can be made for an e-mail. As noted above, the claims are not directed to a user setting up an e-mail for a distribution.

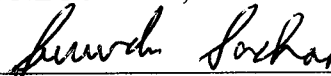
In maintaining the rejection the Office Action indicates there is a suggestion to combine the Microsoft Office System with that in Lesnick and Gillings "to be able to send documents to multiple users in one single transmission".

In reply Applicants submit the outstanding rejection is erroneous in not properly considering that in the Microsoft Office the entire objective of the cited disclosures therein is directed to allowing a user to set up an e-mail for distribution, whereas the claims are directed to automatically routing a document to a user group without such an input.

The outstanding rejection contains numerous errors and must be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

Surinder Sachar
Registration No. 34,423